

Appl. No. 09/910,270

Response dated Oct. 12, 2005

Regarding Office Action dated July 12, 2005

Docket No. BOC9-2000-0058 (193)

REMARKS/ARGUMENTS

These remarks are offered in response to the Office Action of July 12, 2005 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 2 of the Office Action, Claims 1-6, 8-14, 16-17 and 21-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,549,612 to Gifford, *et al.* (Gifford). In paragraphs 3 through 5, Claims 7, 15, 18-20 and 38-40 were rejected under U.S.C. § 103(a) as being unpatentable over Gifford in view of U.S. Patent No. 5,937,162 to Funk, *et al.* (Funk). In paragraph 6, Claims 41-43 were rejected under U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,680,551 to Martino, II (Martino) in view of Gifford. Finally, Claim 44 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gifford in view of Martino and in further view of Funk.

Applicants have amended independent Claims 1, 10, 21, 30, 41, and 44 to further emphasize certain aspects of Applicants' invention. As discussed herein, the amendments are supported throughout the Specification. No new matter has been introduced by virtue of the amendments.

It may be useful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, typified by amended independent Claim 1, is an e-mail communication method that includes inserting a voice communications identifier in an e-mail message. The voice communications identifier is inserted in the e-mail message sent by a sender to a recipient over a data communications network. (See, e.g., Specification, p. 3, lines 2-8 and p. 8, lines 3-6.) According to the method, a voice communications link is established between the sender and the recipient in response to the recipient's selecting the voice communications identifier. (See, e.g., Specification, p. 9, lines 11-21.)

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As already noted, independent Claims 1, 10, 21, and 30 were rejected as being anticipated by Gifford. Applicants respectfully submit, however, that Gifford fails to teach, either expressly or inherently, each of the claims as amended.

Gifford is directed to a method and system for providing a unified communications (UC) service to a subscriber of the service. More particularly with Gifford, a subscriber communicates in various modes via e-mail messages with a UC server. (See, e.g., Col. 2 lines 29-47; see also Col. 6, line 40 through Col. 7, line 27.)

In a portion cited at page 2 of the Office Action, the mechanism by which a communications link is established by Gifford is explicitly described:

- "1) When a caller leaves a voice message for the subscriber, the message is stored digitally on the computer(s) of the UC service provider.
- 2) The UC service provider then sends, via e-mail, a standard MIME encoded (or similar document) to the subscriber which contains at least one part. The first part is a standard HTML, WML or XML formatted document which contains interaction controls (e.g., URL links or form elements) linked back to at least one server side program. When one of the interaction controls is selected, a message is sent back to the server causing the server to perform a corresponding one of the communication services." (Col. 6, lines 43-56.)

The communications services referred to in the passage are elsewhere described as phone, fax, and video services. (See Col. 7, lines 28-30.)

As these passages demonstrate, Gifford does not establish a voice communications link between a sender and a recipient based on a recipient's selecting a voice communication identifier inserted into an e-mail, as recited in amended independent Claims 1, 10, 21, and 30. With Gifford, establishing a communications link requires that a caller call and leave a voice message for the subscriber. The service responds with an e-mail message to the subscriber from the UC server. The subscriber then has the option

Appln. No. 09/910,270
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Docket No. BOC9-2000-0058 (193)

of selecting "one of the interaction controls," which is sent back to the UC server "causing the server to perform a corresponding one of the communications services." (Col. 6, lines 53-56.) When a link is established, it is a link between the subscriber and the party who left the voice message.

Gifford, as the language demonstrates, teaches something other than establishing a voice communications link between a sender and a recipient of an e-mail based on the recipient's selecting a voice communications identifier inserted in the e-mail. In Gifford, the sender of the e-mail is the UC server. The voice communications link in Gifford is established between a caller who leaves a voice message and the subscriber for whom the caller has left the message. The subscriber communicates with the UC server not by voice but via "URL links or other form elements." (Col. 6, lines 49-53.) In Applicants' invention, a voice communications link is established between the sender of the e-mail in which is inserted a voice communications identifier and the recipient of the e-mail, as recited in amended independent Claims 1, 10, 21, and 30.

That the communications link established with Gifford is not between a sender of an e-mail and its recipient is demonstrated in other portions of the reference as well. In describing the corresponding method of providing communication services, Gifford describes the sending of a message to a "notification server" in response to a subscriber receiving a voicemail or facsimile message. (Col. 14, lines 42-46.) The subscriber can respond to the server to initiate a communications link, but again, there is no direct e-mail from a sender that includes a voice communications identifier that can be selected to establish a voice communications link between the sender and the recipient. With Applicants' invention, the sender sends an e-mail, and the recipient selects the voice communications identifier; this is all that is needed to establish a voice communications link between the sender and recipient.

Applicants respectfully maintain, therefore, that Gifford fails to expressly or inherently teach every feature recited in independent Claims 1, 10, 21, and 30, as

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Docket No. BOC9-2000-0058 (193)

amended, and that the claims thus define over the prior art. Applicants further respectfully maintain that Claims 2-9, 11-20, 22-29, and 31-40 each depend from one of the amended independent claims while reciting additional features and that these claims also define over the prior art.

As further noted above, independent Claim 41 was rejected as unpatentable over Martino in view of Gifford. At page 10 of the Office Action it is noted that the former reference fails to disclose establishing a voice communications link between sending and recipient nodes, wherein the sending node conveys an electronic message with executable voice communications link program. Gifford is again cited as establishing this feature.

Gifford, however, does not disclose the establishment of a voice communications link between sending and recipient nodes using an executable voice communications link program in an electronic message from a sender, as recited in amended independent Claim 41. As described above, Gifford provides that an e-mail message is sent by a UC server when a subscriber receives a voice message or facsimile. The subscriber is then able to send a return message, but the return message is to the UC server to instruct the UC to establish the communications link. (See Col. 6, lines 53-61; see also Col. 14, line 42-27.) The voice communications link is established not between the UC server and the subscriber, but between the subscriber and the party who left the voice message or sent the facsimile. Again, the subscriber communicates with the UC server not by voice but via "URL links or other form elements." (Col. 6, lines 49-53.) This is fundamentally different from Applicants' invention. Applicants therefore respectfully maintain that the combination of Martino and Gifford fails to teach or suggest each feature of amended independent Claim 41 and that the claim defines over the prior art.

Claim 44, as also noted above, was rejected as unpatentable over Gifford in view of Martino and Funk. Gifford is again cited for teaching or suggesting establishing a voice communications link between a sender and receiver of an e-mail. As already described, however, the sender of an e-mail in Gifford is a UC server, responding to a

Appln. No. 09/910,270
Response dated Oct. 12, 2005
Regarding Office Action dated July 12, 2005
Docket No. BOC9-2000-0058 (193)

subscriber's having received a voice message or facsimile. When a voice communications link is established in Gifford, it is not with the server; it is with the sender of the voice message or facsimile. Accordingly, Applicants maintain that the combination of Gifford, Martino, and Funk fails to teach or suggest each feature of amended independent Claim 44 and that the claim defines over the prior art.

CONCLUSION

Applicants believe that this application is now in full condition for allowance. Allowance is therefore respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Marc A. Boillot, Registration No. 56,164
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000